

## REMARKS

Claims 1-15, as amended, appear in the application for the Examiner's reconsideration. Claim 1 has been amended to recite that the microemulsion of the present invention is edible, and that surfactant system is of the "non-ionic" type. These amendments find support on page 2, line 30 and on page 1, lines 12-13, respectively. Claim 6 has been amended to replace all trademarks with the corresponding chemical names, which are included on page 5, lines 10-23 of the specification. As no new matter has been introduced, the entry of the claim amendments is warranted.

Claims 1, 7, 9 and 10 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,374,614 to Behan et al. (hereafter "Behan"). Specifically, the Examiner states that Behan discloses a perfume that contains a microemulsion containing all of the ingredients that are set forth in the present claims. Applicants respectfully traverse.

Behan discloses microemulsions comprising a perfume oil, aqueous phase, a primary surfactant and one or more co-surfactants including a quantity of ionic co-surfactant (column 3, lines 24-28). First of all, Behan concerns only microemulsions based on the use of perfuming ingredients (col. 1, lines 4-5). The application of the microemulsions of Behan in the perfumery industry dictates certain limitations of their ingredients. For example, Ethanol and other lower aliphatic alcohols are not recommended for the invention of Behan because they may interfere with the perfume due to its distinct odor (col. 1, lines 29-30). Furthermore, Behan also teaches that in perfume which are applied to skin or hair, the presence of certain surfactants, notably anionic surfactants, should be limited because of possible adverse reaction with the skin (col. 2, line 64, to col. 3, line 1).

Moreover, the surfactant system disclosed by Behan comprises a co-surfactant, which is used to improve the solubilizing properties of the primary surfactant and/or to provide extended temperature stability of the microemulsions (column 6, lines 39-43). Behan specifically states that the presence of a certain minimum quantity of co-surfactant of the ionic type is required for optimum stability (column 6, lines 45-47). In other words, Behan teaches the formulation of a perfuming microemulsion wherein the presence of ionic co-surfactant is required, and wherein the use of anionic surfactants and lower aliphatic alcohols are not recommended.

In contrast, the present invention relates to an edible, thermodynamically stable, microemulsion comprising at least 30% of oil, from 1 to 30% of a non-ionic surfactant system having an HLB comprised between 9 and 18, less than 20% of co-solvent and at least

30% of water. An edible product or composition implies that the microemulsion of the present invention is entirely composed of food grade quality components (p. 2, lines 30-31). This is an entirely different focus than that of Behan because the latter deals with a perfume rather than an edible composition.

Moreover, the surfactant system of the microemulsions covered by the present invention is of the non-ionic type, and comprises in particular, at least two non-ionic food grade surfactants (see page 1, lines 12-13). Furthermore, the surfactant system of the present invention does not require the presence of an ionic co-surfactant to provide stable compositions as taught by Behan. Still, contrary to the recommendation of Behan, the present invention explicitly states that a lower aliphatic alcohol, such as ethanol, may be used as a co-solvent (p.3, line 17-18). Therefore, in view of the teaching of Behan, Applicants surprisingly find that the entirely non-ionic surfactant system of the present invention provides microemulsions which are thermodynamically stable over a very wide range of temperatures. Example 3 illustrates in particular the stability of the edible microemulsions of the invention in clear beverages at temperatures varying between 4.4°C and 32.2°C (page 9).

Since Behan fails to teach either the formulation of an edible composition, i.e. a composition based on food grade ingredients, or the formulation of microemulsions based only on the use of a non-ionic surfactant system, it does not anticipate the present invention. In fact, Behan teaches away from the present invention: One skilled person in the art confronted with the problem of preparing a thermodynamically stable microemulsion, guided by Behan, would not have used a surfactant system free of ionic surfactant. Such a skilled artisan, would therefore have no reasonable expectation of success in preparing stable microemulsion based on a non-ionic system as presently claimed. Thus, the Examiner's rejection has been overcome and should be withdrawn.

Claims 1-10, 13 and 15 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, the Examiner states that only edible microemulsion are contemplated. In response, Applicants have amended claim 1 to recite edible microemulsion specifically. Claim 6 was rejected for containing trademarks. In response, Applicants have replaced the trademarks in claim 6 with corresponding chemical names. Thus, the Examiner's rejections have been overcome and should be withdrawn.

Claims 1-10, 13 and 15 were rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for edible microemulsions, does not

reasonably provide enablement for any and all microemulsions. Applicants' amending claim 1 to recite edible microemulsions renders the rejection moot.

In view of the above, Applicants submit that the entire application is now in condition of allowance, early notice of which would be appreciated. Should the Examiner not agree with the Applicants' position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

The references cited on the information disclosure statement being filed of even date herewith are of category "A" so that they do not affect the patentability of the present claims. Accordingly, the application should be allowed.

Date: \_\_\_\_\_

4/21/03

Respectfully submitted,



Allan A. Fanucci

(Reg. No. 30,256)

**WINSTON & STRAWN**

Customer Number 28765

(212) 294-3311